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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,024	10/19/2001	Ercan E. Kuruoglu	110915	7124
27074 7590 01/24/2007 OLIFF & BERRIDGE, PLC. P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER PAULA, CESAR B	
			ART UNIT 2178	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		01/24/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/982,024

Applicant(s)

KURUOGLU ET AL.

Examiner

CESAR B. PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the amendment filed on 11/1/2006.

This action is made Final.

2. In the amendment, claims 1-20 are pending in the case. Claims 1, and 8 are independent claims.

3. The rejection of claims 1-6, 8-13, and 17-18 rejected under 35 U.S.C. 102(e) as being anticipated by Ma et al, hereinafter Ma (Pat.# 5,909,805 B2, 6/21/2005, filed on 1/31/2001), have been withdrawn as necessitated by the amendment.

4. The rejection of claims 7, and 15-16 rejected under 35 U.S.C. 103(a) as being unpatentable over Manly, in view of Kurosawa et al, hereinafter Kurosawa (Pat. # 6,751,779 B1, 6/15/04, filed on 3/20/2000), have been withdrawn as necessitated by the amendment.

5. The rejection of claim 14 rejected under 35 U.S.C. 103(a) as being unpatentable over Ma, in view of Kupiec (Pat. # 6,533,822 B2, 3/18/03, filed on 1/30/98, as disclosed in pto-892 mailed on 8/25/04), have been withdrawn as necessitated by the amendment.

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6. The rejection of claims 19-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Ma, in view of Lerner et al, hereinafter Lerner (Pat.# 6,859,909, 2/22/2005, filed on 3/7/2000), have been withdrawn as necessitated by the amendment.

Drawings

7. The drawings filed on 10/19/2001 have been approved by the examiner.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-6, 8-13, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manly (Pat.# 3,714,636, 1/30/1973), in view of Ma et al, hereinafter Ma (Pat.# 5,909,805 B2, 6/21/2005, filed on 1/31/2001).

Regarding independent claim 1, Manly discloses reading or scanning a typewritten document containing printed text, and handwritten annotation edit marks made by an author—*capturing an original image of a document* -- (col. 1, lines 21-67). The edit marks, such as delete marks instruct the system to extract the text, which does not include the portions to be deleted from the document--*a processing device for detecting annotations made to the document*

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prior to image capture, the annotations identifying lesser portions of text to be extracted from machine generated text of the original image of the document, the processing device determining the lesser portions of text of the document identified by the annotations to be extracted, and extracting only the lesser portions of text from the machine generated text from of the original image of the document, being identified by the detected annotations; a summary generator for generating a summary including only the extracted lesser portions of text from the machine generated text of the document. Manly fails to explicitly disclose: *the summary condensed version of the machine generated text of the original image of the document and being generated as a separate electronic image document that is different from the original image.* However, Ma discloses the saving of the extracted handwritten annotations into memory (col. 7, lines 52-61, fig. 7-8, fig.). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combined Manly, and Ma, because of all the reasons found in Ma, including increasing the flexibility of having multiple formats, and efficient separation of document data (col. 2, lines 30-37).

Regarding claim 2, which depends on claim 1, Manly discloses generating a document containing original document data without deleted data portions. The typewritten document contains printed text, and handwritten annotation edit marks made by an author—*capturing an original image of a document* (col. 1, lines 21-67) —*generate a summary of the same document as that on which the annotations are detected.*

Regarding claim 3, which depends on claim 1, Manly discloses reading or scanning a typewritten document containing printed text, and handwritten annotation edit marks, into a new

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record in the editing system (col. 1, lines 21-67)—*generate a summary of a different document as that on which the annotations are detected.*

Regarding claim 4, which depends on claim 1, Manly discloses reading or scanning a typewritten document containing printed text, and handwritten annotation edit marks, into a new record in the editing system. The document is edited based on the edit marks (col. 1, lines 21-67)—*capture an image of a second document to be summarized based on detected annotations from a first document.*

Regarding claim 5, which depends on claim 1, Manly discloses reading or scanning from a typewritten document containing printed text, and handwritten annotation edit marks, into a new record in the editing system (col. 1, lines 21-67). In other words, an image of the portion(s) deleted from the document is detected based upon the edit marks—*image region associated with a detected annotation.*

Regarding claim 6, which depends on claim 5, Manly discloses reading or scanning a typewritten document containing printed text, and handwritten annotation edit marks, into a new record in the editing system. A portion of any size in the document is marked up for editing, such as deletion (col. 1, lines 21-67). In other words, a portion(s) deleted from the document is detected based upon the edit marks—*image region associated with a detected annotation, the image region represents a sentence in the document image to provide context for the identified annotation.*

Claims 8-13 are directed towards a method for implementing the system found in claims 1-6 respectively, and therefore are similarly rejected.

Regarding claim 17, which depends on claim 1, Manly discloses reading or scanning a typewritten document containing printed text, and handwritten annotation edit marks, into a new record in the editing system (col. 1, lines 21-67)-- *extracting image maps of the original image of the document.*

Claim 18 is directed towards a method for implementing the steps found in claim 8, and therefore is similarly rejected.

10. Claims 7, and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manly, in view of Bornstein et al, hereinafter Bornstein (Pat. # 6,751,779 B1, 6/15/04, filed on 3/20/2000).

Regarding claim 7, which depends on claim 1, Manly discloses reading or scanning from a typewritten document containing printed text, and handwritten annotation edit marks, into a new record in the editing system using the marks (col. 1, lines 21-67). Manly fails to explicitly disclose: *a summary comprising portions which are selectively expandable to increase the information in that portion of the summary.* However, Bornstein teaches the increasing the sentences in a summary based upon the selection of a user-variable control (col.3, lines 16-40, col.4, lines 19-67, fig.3, 2). It would have been obvious to a person of ordinary skill in the art at

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the time of the invention to combined Manly, and Bornstein, because of all the reasons found in Bornstein, including allowing a user to rapidly review a document based on the level of interest on such document (col. 2, lines 17-30).

Regarding claim 15, which depends on claim 1, Manly discloses reading or scanning from a typewritten document containing printed text, and handwritten annotation edit marks, into a new record in the editing system using the marks (col. 1, lines 21-67). Manly fails to explicitly disclose: *the summary includes expandable detail levels*. However, Bornstein teaches the increasing the sentences in a summary based upon the selection of a user-variable control (col.3, lines 16-40, col.4, lines 19-67, fig.3, 2). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combined Manly, and Bornstein, because of all the reasons found in Bornstein, including allowing a user to rapidly review a document based on the level of interest on such document (col. 2, lines 17-30).

Claim 16 is directed towards a method for implementing the apparatus found in claim 15, and therefore is similarly rejected.

11. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Manly, in view of Kupiec (Pat. # 6,533,822 B2, 3/18/03, filed on 1/30/98, as disclosed in pto-892 mailed on 8/25/04).

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Claim 14 is directed towards a method for implementing the system found in claim 7, except that Manly fails to explicitly disclose *hidden portions, which are selectively expandable*. However, Kupiec teaches the generation of a summary along with indicators that indicate and display the location where extracted text was originally located (col.1, lines 26-67, fig.4). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Manly, and Kupiec, because of all the reasons found in Kupiec, including avoiding the scanning of the whole document to find parts of the document that corresponding to portions of the summary (col.1, lines 14-67), and therefore is similarly rejected.

12. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Manly, in view of Lerner et al, hereinafter Lerner (Pat.# 6,859,909, 2/22/2005, filed on 3/7/2000).

Regarding claim 19, which depends on claim 1, Manly discloses reading or scanning from a typewritten document containing printed text, and handwritten annotation edit marks, into a new record in the editing system using the marks (col. 1, lines 21-67). Manly fails to explicitly disclose: *the summary includes at least one of a pointer and address indicating a place in the original image of the document from which the extracted portions are extracted*. However, Lerner that the storing a list of x and y coordinates of the locations where the user draws the annotations (col. 15, lines 27-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combined Manly, and Lerner, for all the reasons listed by Lerner including the effective integration of text, ink, and highlighter to annotate web documents

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(col. 1, lines 26-36), thereby making the web page easier to share the user's thoughts, and make it more interactive.

Claim 20 is directed towards a method for implementing the apparatus found in claim 19, and therefore is similarly rejected.

Response to Arguments

13. Applicant's arguments filed 11/8/2006 have been fully considered but they are moot in light of the newly applied prior art. Regarding claims 1, 7-8, and 14-16, Applicants submit that Ma, or Kurosawa do not teach or suggest amended claims (pages 6-10). The Applicants are directed towards the rejection of these claims above in light of the prior art as necessitated by the amendment

Claims 2-7, and 9-16 depend from claims 1, and 18, and therefore are rejected at least based on the same information above.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coleman et al. (Pat. 3,781,816), Agulnick et al. (Pat. # A 5,347,295 A), Marshall et al. (Pat. # 2003/0070139 A1), Schilit et al. (Pat. # 6,687,876 B1, and 6,279,014 B1), and Thielens et al. (Pat. # # 5,666,139 A).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
1/19/07